

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, Colorado 80527-2400

JUN 07 2006

PATENT APPLICATION

ATTORNEY D JCKET NO. 10003225-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert E. Haines et al.

Confirmation No.: 5548

Application No.: 09/981,117

Examiner: Lucas Device

Filing Date: 10/17/2001

Group Art Unit: 2624

Title: Image Forming Devices and Methods of Forming Hard Images

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 4/12/2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

() one month	\$120.00
() two months	\$450.00
() three months	\$1020.00
() four months	\$1690.00

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

() I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450. Date of Deposit: 6/7/06

OR

(X) I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (571) 273-8300 on 6/7/2006

Number of pages: 28Typed Name: Natalie KingSignature: [Signature]

Respectfully submitted,

Robert E. Haines et al.

By [Signature]

James D. Shaurelto

Attorney/Agent for Applicant(s)

Reg. No. 39,133

Date: 6/7/06

Telephone No.: (501) 624-4276

Rev 12/04 (Aolbrief)

JUN 07 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.09/981,117
Filing Date..... October 17, 2001
Inventor.....Robert E. Haines et al.
Assignee..... Hewlett-Packard Development Company, L.P.
Group Art Unit 2624
Examiner..... Lucas Devine
Attorney's Docket No..... PDNO. 10003225-1
Confirmation No..... 5546
Title: Image Forming Devices and Methods of Forming Hard Images

BRIEF OF APPELLANT

To: Mail Stop Appeal Brief-Patents
Commissioner of Patents
P.O. Box 1450
Alexandria VA 22313-1450

From: James D. Shaurette (Tel. 509-624-4276; Fax 509-838-3424)
Wells, St. John, P.S.
601 W. First Avenue, Suite 1300
Spokane, WA 99201-3817

Appellant appeals from the Office Action mailed January 12, 2006 (hereinafter "Office Action") which rejects claims 1-11, 13-17 and 20-23. The Commissioner is authorized to charge the fee required under 37 C.F.R. § 41.20(b)(2) to Deposit Account No. 08-2025.

06/08/2006 TL0111 00000051 002025 09981117
01 FC:1402 500.00 DA

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

-i-

TABLE OF CONTENTS

I.	<u>REAL PROPERTY IN INTEREST</u>	1
II.	<u>RELATED APPEALS AND INTERFERENCES</u>	1
III.	<u>STATUS OF CLAIMS</u>	1
IV.	<u>STATUS OF AMENDMENTS</u>	1
V.	<u>SUMMARY OF CLAIMED SUBJECT MATTER</u>	1
VI.	<u>GROUND OF REJECTION TO BE REVIEWED ON APPEAL</u>	2
VII.	<u>ARGUMENT</u>	3
	A. Claims 21 and 22 comply with the written description requirement and do not introduce new matter.....	3
	B. There is insufficient motivation to combine the prior art teachings of Kawabata with the teachings of Siwinski and the 103 rejection of claims 1-5, 11 and 21 is improper.....	5
	C. There is insufficient motivation to combine the prior art teachings of Matthews with the teachings of Siwinski and the 103 rejection of claims 6-8, 10, 13-17, 20 and 22-23 is improper.....	8
	D. Positively recited limitations of claims 6, 7, 13-17, 20 and 22-23 are not taught even if the teachings of Matthews are combined with the teachings of Siwinski and the 103 rejection of claims 6, 7, 13-17, 20 and 22-23 is improper.....	11
	E. Positively recited limitations of claim 7 are not disclosed nor suggested by the prior art and the rejection of claim 7 is improper.....	12
	F. There is insufficient motivation to combine the teachings of Arima with the teachings of Siwinski, the limitations of claim 8 are not well known, and the rejection of claim 8 is improper.....	13

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

-ii-

G.	Positively recited limitations of claim 23 are not taught even if the teachings of Matthews are combined with the teachings of Siwinski and the 103 rejection of claim 23 is improper.....	14
H.	The title is consistent with the requirements of the CFR and MPEP and is appropriate.....	15
I.	Conclusion.....	16
VIII.	<u>CLAIMS APPENDIX</u>	A-1
IX.	<u>EVIDENCE APPENDIX</u>	B-1
X.	<u>RELATED PROCEEDINGS APPENDIX</u>	C-1

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

I. REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC") as evidenced by the full assignment of the pending application to Hewlett-Packard Company recorded starting at Reel 012274, Frame 0715, and the full assignment to Hewlett-Packard Development Company L.P. recorded at Reel 014061, Frame 0492, in the Assignment Branch of the Patent and Trademark Office. HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' undersigned legal representative, and the assignee of the pending application are aware of no appeals or interferences which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF THE CLAIMS

Claims 1-11, 13-17 and 20-23 are pending and stand rejected. Appellants appeal the rejection of claims 1-11, 13-17, and 20-23.

IV. STATUS OF AMENDMENTS

Appellants filed an amendment on June 7, 2006 to cancel claim 19 in accordance with 37 CFR 41.33(b)(1).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the subject matter defined in each of the independent claims and argued dependent claims involved in the appeal follow with respect to exemplary illustrative embodiments of the specification and figures.

Referring to Independent claim 1, an exemplary image forming device 10 of Fig. 2 is described beginning at page 4, paragraph line 9 of the specification according to one embodiment. The illustrated image forming device 10 includes a

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

housing 14. Fig. 3 shows imaging circuitry 20 according to one embodiment and sensors 26, 30. Details of Fig. 3 according to one embodiment are described at page 7, lines 12+ of the specification.

Referring to dependent claim 6, an exemplary interface is shown as reference 28 of Fig. 3. Exemplary communication of messages using interface 28 is described in one example at page 10, lines 23+ of the originally filed specification.

Referring to dependent claim 7, page 11, lines 1+ of the originally filed specification states that generated messages communicated from image forming device 10 may identify the type and brand of media according to one embodiment.

Referring to dependent claim 8, the originally filed specification states at page 11, lines 10+ that messages may comprise an order to assist with replenishment of media.

Referring to independent claim 13, Fig. 2 and page 4, lines 9+ of the specification disclose a media path 16 to guide media within housing 14. Forming of images is described at page 5, lines 6+ in one embodiment with respect to a developing assembly 22 and fusing assembly 24. Exemplary communication of messages using interface 28 is described in one example at page 10, lines 23+ of the originally filed specification.

Referring to dependent claim 23, control circuitry 34 is disclosed in one embodiment as generating messages responsive to encoded data retrieved from media and the messages are applied to interface 28 for communication.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. The 112, first paragraph, rejection of claims 21-22.
- B. The 103 rejection of claims 1-5, 11 and 21.
- C. The 103 rejection of claims 6-8, 10, 13-17, 20 and 22-23.
- D. The 103 rejection of claims 6, 7, 13-17, 20 and 22-23.
- E. The 103 rejection of claim 7.
- F. The 103 rejection of claim 8.
- G. The 103 rejection of claim 23.
- H. The objection to the title.

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

VII. ARGUMENT

A. Claims 21 and 22 comply with the written description requirement and do not introduce new matter.

Regarding the rejection based on 112, first paragraph, the Examiner is respectfully reminded that the MPEP states the test for sufficiency of support in a application is whether the disclosure relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter. MPEP §2163.02 (8th ed., rev. 3) *citing Ralston Purina Co. v Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985). Notably, the subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. MPEP §2163.02 (8th ed., rev. 3).

MPEP §2163 I. (8th ed., rev. 3) states it is now well accepted that a satisfactory description may be in the claims or any other portion of the originally-filed specification and an applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.

Referring to Fig. 2 of the originally filed application, plural sensors 30 are shown. Starting at page 6, lines 28 of the specification, it is stated that additional sensors 30 are provided to monitor at least one ambient condition within the environment of the image forming device 10. The sensors 30 are configured to output signals indicative of the at least one ambient condition. It is further states that *sensors 30 are operable to monitor temperature, humidity, and/or other ambient conditions about image forming device 10.*

Appellants respectfully submit that claims 21-22 comply with the written description requirement at least in consideration of the above-recited teachings of the originally filed application and the claims 21-22 do not recite new matter. In particular, the teachings of the specification that the sensors 30 are operable to monitor temperature, humidity and/or other ambient conditions at out image forming device 10 reasonably convey to the artisan that the Appellants had possession of sensors of claims 21-22 configured to monitor the ambient condition external of the

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

housing of the image forming device and monitoring an ambient condition external of a housing of the image forming device, respectively.

Appellants respectfully submit the claims are supported by the originally filed application at least as identified above and in addition in view of the following. MPEP § 2163.07(a) (8th ed., rev. 3) states that by disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F.2d 1376, 178 USPQ 279 (CCPA 1973).

It is clear Appellants have disclosed monitoring ambient conditions about the image forming device 10. In accordance with the MPEP, Appellants' claiming of monitoring of the ambient condition external of the housing of the image forming device is inherently disclosed by the monitoring of the ambient conditions about the image forming device 10 and the limitations of the claims 21 and 22 are not new matter.

Applicants note MPEP 2163 II. A. (8th ed., rev. 3), states the Examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. Further, it is stated that if Appellants points out where a claim is supported (as Appellants did at page 13 of the Response filed by Appellants on October 13, 2005), the Examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined in the claims.

Further, MPEP §2163.III.A (8th ed., rev. 3) provides in rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:

- (A) Identify the claim limitation at issue; and
- (B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.

The Office Action at page 4 merely states "applicant's originally filed specification provides no support for 'monitor an ambient condition external of the housing'" with no evidence or reasoning. The Office fails to address the specification or explain how a person skilled in the art would not have recognized that the Appellants were in possession of the limitations of claims 21-22 in view of the explicit teachings of the original disclosure that the sensors 30 are provided to monitor at least one ambient condition within the environment of the image forming device and that sensors 30 are operable to monitor temperature, humidity and/or other ambient conditions about the image forming device. Appellants submit that the 112 rejections of claims 21-22 fail to meet the clear mandate of the MPEP set forth above and the Office has failed to establish a *prima facie* 112 rejection for at least the above-mentioned compelling reasons. Appellants respectfully request reversal of the 112 rejections of claims 21-22 for the above-cited compelling reasons.

B. There is insufficient motivation to combine the prior art teachings of Kawabata with the teachings of Siwinski and the 103 rejection of claims 1-5, 11 and 21 is improper.

The Office at page 5 of the Office Action states that Siwinski does not teach an ambient condition sensor or printing based on the signal therefrom. The Office relies upon Kawabata in support of the rejection. Appellants respectfully submit that the Office has failed to establish a proper *prima facie* 103 rejection, and accordingly, the reliance upon Kawabata to cure the deficiencies of Siwinski is misplaced and improper.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 3).

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

MPEP 2142 (8th ed., rev. 3) states that the concept of prima facie obviousness allocates who has the burden of going forward with production of evidence in each step of the examination process and *the examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness.* The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness, that is, the initial burden is on the examiner *to provide some suggestion of the desirability of doing what the inventor has done.* MPEP §2142 (8th ed., rev. 3).

Applicants respectfully submit the motivational rationale to combine the references provided by the Office is insufficient in view of precedent set forth by the Federal Circuit, and accordingly, the Office has failed to meet their burden of establishing a proper prima facie 103 rejection.

The Federal Circuit discussed proper motivation *In re Lee*, 41 USPQ 2d 1430 (Fed. Cir. 2002). The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1781, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court additionally stated that the factual question of motivation is material to patentability and *can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense but rather specific factual findings are needed.* The Court further stated that the *determination of patentability must be based on evidence.* MPEP 2143.01 (8th ed., rev. 3) cites *In re Lee* and states the importance of relying upon objective evidence and making specific factual findings with respect to the motivation to combine references.

The Office at pages 5-6 identifies teachings of Kawabata which allegedly disclose limitations of claim 1, and then on page 6 states that *Based on this clear motivation taught in the art* it would have been obvious to include the second sensor functions of Kawabata in the media type detecting and printing system of

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

Siwinski. Appellants respectfully submit the alleged motivation is deficient for the following numerous reasons.

Initially, the Office merely recites teachings of Kawabata which allegedly disclose limitations of the claims as providing the motivation and provides no explanation as to why one of skill in the art would be motivated to combine the reference teachings in the first instance. Appellants respectfully submit that the mere identification of reference teachings by the Office which allegedly teach limitations of the claims without providing a rationale as to why one of skill would combine the references as proposed by the Office is insufficient, and the Office has failed to meet their burden of factually supporting the conclusion of obvious by factually showing the suggestion of the desirability of doing what the inventor has done. MPEP §2142 (8th ed., rev. 3).

Appellants respectfully submit that the following authority also illustrates the failure of the Office to establish a *prima facie* 103 rejection of claim 1. In particular, the mere identification of teachings which allegedly disclose the limitations of the claims is insufficient inasmuch as the mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01III (8th ed., rev. 3) *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Preferably the Examiner's explanation should be such that it provides that impetus necessary to cause one skilled in the art to combine the teachings of the references to make the proposed modification. *Ex Parte Levengood*, 28 USPQ2d, 1300, 1301, Footnote 2, (Bd. Pat. App. and Inter. 1993). The Examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's inventions without also providing evidence of the motivational force which would impel one skilled in the art to do what the patent applicant has done. *Ex Parte Levengood* 28 USPQ2d 1300, 1302. (Bd. Pat. App. & Inter. 1993). MPEP 2144 (8th ed., rev. 3).

Appellants also note that Kawabata is directed towards resolving problems associated with transfer material of a *multilayer structure* such as: a tack film, cloth paper or a transfer material formed with a bonding layer as set forth in col. 1, lines 7-14 of Kawabata. At col. 11, lines 7+ of Kawabata, it is disclosed that variables of tack film, cloth paper and transfer material formed with thermally melted bonding

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

layer are measured under standard conditions and subsequent values may be multiplied by respective coefficients to execute temperature and humidity corrections. However, Appellants have failed to uncover any teachings in Siwinski of problems or concerns of printing with multilayer structures which are addressed by the specific teachings of Kawabata directed towards alleviating problems associated with printing on multilayer structures. The solutions of Kawabata have not been demonstrated to be applicable to operations of Siwinski or provide any improvement thereto to motivate one to combine the reference teachings as combined by the Office.

Appellants respectfully submit that the mere identification of teachings which allegedly correspond to limitations of Appellants' claim 1 does not provide any motivation let alone clear motivation to combine the reference teachings.

There is no *objective evidence of record* that any improved operations of the primary reference would result from the combination proposed by the Office. The only motivational rationale provided by the Office is unsupported and conclusory and/or improperly based upon Appellants' own teachings. Appellants respectfully submit the Office has failed to meet their burden of establishing proper motivation for at least the above-mentioned compelling reasons and Appellants request withdrawal of the 103 rejection in the next Action.

C. There is insufficient motivation to combine the prior art teachings of Matthews with the teachings of Siwinski and the 103 rejection of claims 6-8, 10, 13-17, 20 and 22-23 is improper.

Appellants respectfully submit the Office has failed to meet their burden of establishing motivation to combine the reference teachings of Matthews with Siwinski and the Office has failed to establish a *prima facie* 103 rejection of the claims for at least this reason.

Referring to pages 8 and 11 of the Office Action with respect to claims 6 and 13, the Office states that Siwinski does not teach a message which identifies media. On pages 8 and 12 of the Office Action, the Office states that one of the messages of Siwinski *could have been* identifying media which is causing jams as shown in Matthews to prevent errors that are caused by that specific media. Appellants respectfully submit the motivational rationale is insufficient.

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

The references of Siwinski and Matthews are directed towards different printing systems. Matthews is directed to a high speed, high output printing system which uses a plurality of media feeders 16-18 where it may be useful to help identify media associated with the different feeders. Siwinski discloses a inkjet printer and Appellants have failed to uncover any multiple media feeders in Siwinski.

Matthews discloses user entered messages at paragraph 0022 which apply to *one of a plurality of feeders 16-18 of a high capacity printing system*. The background of Matthews provides solutions to a problem by permitting a user to make notes regarding operations of individual ones of the plurality of provider feeders in particular to note that a brand of paper causes jams for one of the feeders. To the contrary, Siwinski merely provides paper 24 via a single tray 24 and there is no need in Siwinski to make notes since the Siwinski system is a straightforward system having a single tray without the plurality of feeders of Matthews.

Appellants have electronically searched and failed to uncover any problems or issues in Siwinski of jams for which user remarks may be useful. In addition, since Siwinski provides a single tray, Siwinski does not suffer from issues of trying to identify different sources of media or use of multiple media feeders of Matthews where confusion may more likely be present. Matthews provides solutions in a printing system entirely different from the system of Siwinski and there is no objective evidence of record of motivation to combine the large multiple feeder printing system teachings of Matthews with the ink jet printer of Siwinski which uses a single media source.

Furthermore, Siwinski at paragraph 0037 merely states the generic operations of the console 30 to provide maintenance and error messages without any clarification as to what the messages may be. Appellants respectfully submit that the generic reference to error messages of Siwinski fails to disclose messages regarding jamming, the combination proposed by the Office addresses problems of no concern to Siwinski, there is no objective evidence to support the combination and the combination of references merely results from improper use of Appellants' disclosure as a roadmap.

Appellants submit that the alleged motivation presented by the Examiner, if deemed sufficient, would open the door to numerous combinations of any art which

PDNO. 10003225-1

Serial No. : 09/981,117

Brief of Appellant

would expand the capabilities of the reference being modified even though the expanded capabilities are not relevant to the problems or solutions of the reference being modified. Appellants submit that the mere combination of reference teachings to expand the capabilities of the disclosure being modified in a manner of no concern to the subject matter or problems of the disclosure being modified would effectively eliminate the requirement to provide proper motivational rationale to formulate a proper 103 rejection. The courts have not eroded or eliminated the requirement for proper motivation and have clearly stated that proper motivation must be supported by objective evidence of record. The Federal Circuit in *In re Lee* has clearly stated that motivation may not be based upon the subjective belief of the Examiner or unknown authority.

Further, as mentioned above, the mere fact that reference(s) *can* be combined or modified is not sufficient *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01(8th ed., rev. 2) *citing In re Mills*, 916 F.2d 680, 18 USPQ2d 1430 (Fed. Cir. 1990). The provision of the ability to make notes in the complex high capacity system of Matthews including a plurality of feeders has not been demonstrated to be of concern to the straightforward ink jet system of Siwinski having a single tray. Appellants respectfully submit the Office has failed to meet their burden of establishing proper motivation for combining the reference teachings and accordingly the Office has failed to establish a proper *prima facie* 103 rejection.

At pages 2-3 in the "Response to Arguments" portion of the Office Action, the Office states that Siwinski teaches automatically providing error messages. Appellants traverse the statement and submit Appellants have failed to uncover any identification of automatic teachings as baldly alleged by the Office. Furthermore, the Office states *a result* if the combination of references are combined as opposed to providing proper motivation to combine the reference teachings in the first place. Appellants again respectfully submit that the problems or issues in Matthews have not been identified as being issues in the more straightforward system of Siwinski to motivate one to combine reference teachings. The mere fact that references can be combined is not sufficient in view of the above-authority and the objective evidence of record fails to establish proper motivation to combine the reference teachings. Siwinski is directed towards accessing information from consumables

PDNO. 10003225-1

Serial No. : 09/981,117

Brief of Appellant

and writing information to consumables and is not concerned with providing error messages regarding paper jams or other specific errors as evidenced by the mere generic, cursory reference in Siwinski to error messages at paragraph 0037. The Office in the 103 rejection looks to expand the operations of Siwinski into areas which have not been demonstrated to be of concern to Siwinski and to solve alleged problems which are not present in Siwinski. Appellants respectfully submit that the Office, in the absence of objective evidence, is using Appellants' disclosure to expand the capabilities of the Siwinski device which do not address any concerns or problems with the operation of Siwinski. Appellants respectfully submit there is insufficient objective evidence of record to support the combination and this lack of evidence demonstrates the inappropriateness of the 103 rejection.

The Office at page 3 further alleges that it doesn't matter how many trays there are in a system. Appellants respectfully disagree. Matthews is directed towards high output system using a plurality of feeders and plural types of media. Accordingly, it is beneficial in the system of Matthews to help users with knowing which of numerous feeders and the numerous media types used thereby are likely to experience problems. To the contrary, Siwinski is directed towards a single feeder system not of the complexity of Matthews and there is no evidence of record that the combination proposed by the Office resolves any issues of concern to Siwinski.

Appellants respectfully submit the Office has failed to meet their burden of establishing proper motivation for combining the reference teachings and accordingly the Office has failed to establish a proper *prima facie* 103 rejection for at least this reason. Appellants respectfully request allowance of the claims.

D. Positively recited limitations of claims 6, 7, 13-17, 20 and 22-23 are not taught even if the teachings of Matthews are combined with the teachings of Siwinski and the 103 rejection of claims 6, 7, 13-17, 20 and 22-23 is improper.

Appellants respectfully submit that positively recited limitations of the claims are not taught even if the teachings of Matthews are combined with the teachings of Siwinski and the Office has failed to establish a proper *prima facie* 103 rejection for at least this reason.

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

The method of claim 13 recites retrieving encoded data from media using an image forming device and performing at least one function comprising *communicating a message identifying the media to a host device using the image forming device responsive to the encoded data*.

The Office states on page 11 of the Action that Siwinski teaches maintenance and error messages but fails to teach that a message identifies the media. Furthermore, Appellants have failed to uncover any teachings in Siwinski that any messages are communicated responsive to encoded data retrieved from media. The Office relies upon the teachings of Matthews and states that paragraph 0022 of Matthews discloses sending an error message to a user identifying media that is causing troubles. Referring to Fig. 2, paragraph 0022, Matthews states that *a user may add a remark warning other users about a particular brand of paper that is causing jams*. To the contrary, claim 13 positively defines *retrieving encoded data from the media and performing at least one function comprising communicating a message identifying the media to the host device responsive to the encoded data*. The inputting of information *by a user* fails to disclose or suggest the claimed *communicating responsive to the encoded data retrieved from the media*.

In addition, the media identified by Matthews is media which may cause jams in the system as a warning for users not to use that type of media. The identification of media *not to be used* in the system fails to disclose or suggest the *message identifying the media which is moving along the media path and having hard images formed thereon* as positively defined in claim 13.

Accordingly, as illustrated above, even if the prior art references are combined, the combination fails to disclose or suggest limitations of claim 13. Appellants respectfully submit the Office has failed to establish a proper *prima facie* 103 rejection of the claims for at least this additional reason.

E. Positively recited limitations of claim 7 are not disclosed nor suggested by the prior art and the rejection of claim 7 is improper.

Claim 7 recites that the *generating the message comprises generating the message to identify the type and brand of the media for display using the host device*. The Office baldly states on page 8 of the Action without identification of

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

prior art teachings that Siwinski teaches type and Matthews teaches brand. Appellants respectfully disagree. Paragraph 0037 of Siwinski merely states that console 30 displays maintenance and error messages. Appellants have failed to uncover any teachings in Siwinski regarding the contents of the messages and the Office has failed to identify the teachings relied upon. In particular, Appellants have failed to uncover any evidence that the messages of console 30 *include type of media as specifically claimed*. Positively recited limitations of claim 7 are not disclosed nor suggested by the prior art even if the teachings of Matthews are combined with the teachings of Siwinski and Appellants respectfully submit the Office has failed to establish a *prima facie* 103 rejection of claim 7 for at least this reason.

F. There is insufficient motivation to combine the teachings of Arima with the teachings of Siwinski, the limitations of claim 8 are not well known, and the rejection of claim 8 is improper.

Referring to page 3 of the Action and with respect to claim 8, the Office cites Arima in response to the traversal of taking of Official Notice in the previous response of Appellants. Appellants respectfully submit that the mere identification of a single reference is insufficient to establish that the limitations of claim 8 are well known. The Examiner is reminded that the facts constituting the state of the art are normally subject to the possibility of rationale disagreement among reasonable men and are not amenable to the taking of judicial notice. See *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973). The Examiner is also reminded that claims are analyzed in the context of the combination of the various separately stated limitations, and not with respect to the limitations individually. Appellants respectfully submit that the identification of a reference which teaches one limitation of a claim which recites a combination of numerous references is insufficient to establish that the limitation is well known.

At page 9 of the Action, Appellants note that the Office now rejects claim 8 over the combination of references including Arima. Appellants respectfully submit there is no motivation to combine the reference teachings and the rejection is improper for at least this reason. The Office at page 9 baldly states that the combination is obvious to provide for prevention of time when the printer cannot be

PDNO. 10003225-1

Serial No. : 09/981,117

Brief of Appellant

used because the supplies are out. Appellants respectfully submit that the alleged motivation is insufficient. More specifically, Siwinski is not directed toward ordering consumables and only generically refers to the operation of control console 30 to display messages. There is no objective evidence of record to motivate one to expand the complexities of Siwinski to operate to order consumables. Furthermore, the combination of Matthews with Siwinski by the Office allegedly provides a user with information regarding inappropriate consumables for use. Accordingly, even if Siwinski is modified per Matthews, the combination is not concerned with notifying a user of expended consumables or ordering but to the contrary of inappropriate consumables which cause paper jamming which are to be avoided.

Appellants have failed to uncover any concerns in Siwinski or Matthews of problems with respect to ordering of consumables. Further, the modification to the Siwinski and Matthews teachings will increase the complexity without addressing any problems of Siwinski or Matthews. Further, providing orders per Arima may result in issues with respect to overstocking consumables when not needed or otherwise negatively impacting the operations of Siwinski without any benefit being identified in the objective evidence of record to motivate one to combine the reference teachings.

Appellants respectfully submit there is no proper motivation to combine the numerous disparate reference teachings of Arima, Matthews and Siwinski and the 103 rejection of claim 8 is improper.

G. Positively recited limitations of claim 23 are not taught even if the teachings of Matthews are combined with the teachings of Siwinski and the 103 rejection of claim 23 is improper.

Claim 23 recites *communicating the message identifying the host device automatically without user input and responsive to encoded data retrieved from media*. At page 12 of the Action, the Office baldly alleges that Siwinski teaches automatically displaying error and maintenance messages with reference to paragraph 0037 of Siwinski. However, referring to paragraph 0037, Siwinski discloses that control console 30 performs operations such as displaying maintenance and error messages without any recitation to the displaying being

PDNO. 10003225-1

Serial No. : 09/981,117

Brief of Appellant

automatic or responsive to encoded data retrieved from media. Appellants have failed to uncover any teachings in Siwinski of automatically displaying error and maintenance messages as positively claimed.

To the contrary, the teachings of Matthews, used in the 103 rejection of claim 23, states that *messages inputted by a user may be displayed*. Accordingly, the combined teachings of Matthews and Siwinski fail to teach the claimed automatic communication without user input and responsive to encoded data, and to the contrary disclose the user inputting the message. When the references teachings are properly considered as a whole it is clear that the references do not teach the automatic communication as defined in claim 23 but to the contrary involve explicit user intervention.

Appellants respectfully submit that the proposed modification or combination of the prior art would require substantial reconstruction or redesign of the reference teachings and/or would change the principle of operation of the prior art which further illustrates that claim 23 is not *prima facie* obvious. MPEP 2143.01(8th ed. rev. 2) citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Appellants respectfully submit that positively recited limitations of claim 23 are not disclosed nor suggested by the prior art even if the references are combined and the Office has failed to establish a *prima facie* 103 rejection for at least this reason.

H. The title is consistent with the requirements of the CFR and MPEP and is appropriate.

Appellants respectfully submit the title is accurate and in compliance with the CFR and MPEP. The Office on page 2 of the Action states that 37 CFR 1.72 states that the title must be as specific as possible while omitting the requirement the *title must also be short* as possible. Appellants respectfully submit that the title complies with the requirements of the CFR and MPEP. In particular, the title corresponds exactly and succinctly to the preambles of the present claims. Accordingly, the title is both specific to the claimed subject matter and also brief. Applicants respectfully assert that the present title of Image Forming Devices and Methods of Forming Hard Images is sufficient for indexing, classification and searching. Appellants respectfully request approval of the title as submitted as

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

16

clearly directly corresponding to the subject matter of the claims, and accordingly, is highly specific and descriptive of the subject matter of the application while also complying with the brevity requirement of the CFR.

I. Conclusion

In view of the foregoing, reversal of the rejections of the claims is respectfully requested. For any one of the above-stated reasons, the rejections of the respective claims should be reversed. In combination, the above-stated reasons overwhelmingly support such reversal. Accordingly, Appellants respectfully request that the Board reverse the rejections of the claims.

Respectfully submitted,

Date:

6/7/06

Attorney:



James D. Shaurett
Reg. No. 39,833

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

A-1

VIII. APPENDIX A – THE CLAIMS INVOLVED IN THIS APPEAL

1 Claim 1 (Previously Presented): An image forming device
2 comprising:
3 a housing including a media path arranged to guide media;
4 a first sensor configured to obtain encoded data from the media
5 and to output a first signal indicative of the encoded data;
6 a second sensor configured to monitor an ambient condition within
7 an environment in which the image forming device is deployed and to output a
8 second signal indicative of the ambient condition; and
9 imaging circuitry configured to form hard images upon the media,
10 to receive the first signal, to receive the second signal, and to perform at least
11 one function with respect to the formation of the hard images within the image
12 forming device responsive to the encoded data indicated within the first signal
13 and the second signal indicative of the ambient condition.

1 Claim 2 (Previously Presented): The image forming device in
2 accordance with claim 1 wherein the first sensor is configured to obtain the
3 encoded data from the media comprising a plurality of discrete sheets.

1 Claim 3 (Original): The image forming device in accordance with
2 claim 1 wherein the imaging circuitry is configured to form the hard images upon
3 the media according to an imaging parameter and to perform the at least one
4 function comprising adjusting the imaging parameter.

1 Claim 4 (Previously Presented): The image forming device in
2 accordance with claim 3 wherein the imaging circuitry is configured to adjust the
3 imaging parameter responsive to the second signal from the second sensor.

1 Claim 5 (Original): The image forming device in accordance with
2 claim 3 further comprising:
3 storage circuitry configured to store a plurality of initial settings for
4 the imaging parameter and corresponding to a plurality of media types, and

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

A-2

5 wherein the imaging circuitry is configured to access at least one of the settings
6 responsive to the encoded data identifying the media; and
7 an interface configured to receive updated settings and wherein
8 the storage circuitry is configured to store the updated settings to replace the
9 initial settings.

1 Claim 6 (Original): The image forming device in accordance with
2 claim 1 further comprising an interface configured to implement communications
3 externally of the image forming device, and wherein the imaging circuitry is
4 configured to perform the at least one function comprising generating a message
5 identifying the media, and applying the message to the interface for
6 communication to a host device coupled with the interface.

1 Claim 7 (Original): The image forming device in accordance with
2 claim 6 wherein the generating the message comprises generating the message
3 to identify the type and the brand of media for display using the host device.

1 Claim 8 (Original): The image forming device in accordance with
2 claim 6 wherein the message comprises an order to assist with replenishment of
3 the media.

1 Claim 9 (Original): The image forming device in accordance with
2 claim 1 wherein the imaging circuitry is configured to perform the at least one
3 function comprising preventing formation of hard images upon the media.

1 Claim 10 (Previously Presented): The image forming device in
2 accordance with claim 1 further comprising:
3 a plurality of media supplies individually configured to supply a
4 given type of media individually having encoded data; and
5 a third sensor, wherein the first and third sensors are individually
6 associated with a respective one of the media supplies and configured to obtain
7 encoded data from the respective media and to output a signal indicative of the
8 encoded data.

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

A-3

1 Claim 11 (Original): The Image forming device in accordance with
2 claim 1 wherein the imaging circuitry is configured to print hard images upon
3 media.

1 Claim 12 (Original): An image forming device comprising:
2 a housing including a media path arranged to guide media;
3 an interface configured to implement communications externally of
4 the image forming device;
5 a plurality of media supplies individually configured to supply sheet
6 media having encoded data;
7 a plurality of first sensors individually associated with a respective
8 one of the media supplies and configured to obtain encoded data from the
9 respective media and to output a signal indicative of the encoded data;
10 a second sensor configured to monitor at least one ambient
11 condition within the environment of the image forming device and to output a
12 signal indicative of the at least one ambient condition;
13 an image engine configured to print hard images upon the media
14 according to an imaging parameter;
15 storage circuitry configured to store a plurality of settings for the
16 imaging parameter and corresponding to a plurality of respective media types;
17 and
18 control circuitry configured to access at least one setting from the
19 storage circuitry responsive to the signals from at least one of the first sensors
20 and the second sensor and to control adjustment of the imaging parameter
21 responsive to the at least one setting, and to generate a message identifying a
22 brand and type of media, and to apply the message to the interface for
23 communication to a host device coupled with the interface to display the brand
24 and the type of media using the host device.

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

A-4

1 Claim 13 (Previously Presented): A method of forming hard images
2 comprising:
3 moving media along a media path of an image forming device;
4 forming hard images upon the media using the image forming
5 device;
6 retrieving encoded data from the media using the image forming
7 device;
8 performing at least one function with respect to the media using
9 the image forming device responsive to the encoded data; and
10 wherein the performing the at least one function comprises
11 communicating a message identifying the media to a host device.

1 Claim 14 (Original): The method in accordance with claim 13
2 wherein the retrieving comprises retrieving the encoded data from the media
3 comprising a plurality of discrete sheets.

1 Claim 15 (Previously Presented): The method in accordance with
2 claim 13 wherein the forming comprises forming according to at least one
3 imaging parameter, and the performing comprises performing another function
4 comprising adjusting the imaging parameter.

1 Claim 16 (Original): The method in accordance with claim 15
2 further comprising monitoring at least one ambient condition within the
3 environment of the image forming device, and wherein the adjusting is further
4 responsive to the monitoring.

1 Claim 17 (Original): The method in accordance with claim 15
2 further comprising:
3 storing a plurality of initial settings for the imaging parameter and
4 corresponding to a plurality of media types;
5 replacing the initial settings with updated settings at a subsequent
6 moment in time; and

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

A-5

7 accessing at least one of the initial settings and the updated
8 settings responsive to the encoded data identifying the media to control the
9 adjusting.

1 Claim 18 (Canceled).

1 Claim 19 (Canceled).

1 Claim 20 (Original): The method in accordance with claim 13
2 wherein the forming hard images comprises printing.

1 Claim 21 (Previously Presented): The image forming device in
2 accordance with claim 1 wherein the second sensor is configured to monitor the
3 ambient condition external of the housing.

1 Claim 22 (Previously Presented): The method in accordance with
2 claim 13 further comprising monitoring an ambient condition external of a
3 housing of the image forming device, and wherein the performing comprises
4 performing another function with respect to the media responsive to the
5 monitoring.

1 Claim 23 (Previously Presented): The method in accordance with
2 claim 13 wherein the communicating comprises automatically communicating
3 without user input.

PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant

B-1

IX. EVIDENCE APPENDIX

Appellants submit no evidence with this appellate brief.

*PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant*

C-1

X. RELATED PROCEEDINGS APPENDIX

Appellants are not aware of any related proceedings.

*PDNO. 10003225-1
Serial No. : 09/981,117
Brief of Appellant*